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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,233	01/19/2000	Scott D. Cook	3878	2923

7590 09/24/2003

GLENN PATENT GROUP
3475 Edison Way
Suite L
Menlo Park, CA 94025

EXAMINER

DASS, HARISH T

ART UNIT

PAPER NUMBER

3628

13

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/487,233

Applicant(s)

COOK ET AL.

Examin r

Harish T Dass

Art Unit

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-- Th MAILING DATE f this communication appears on the c ver sh et with the correspondenc address --
Period f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 and 85-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-83 and 85-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim 84 is canceled.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 6-11, 15, 17-31, 33-37, 39-49, 52-56, 59-68, 71-88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, particularly, an abstract idea.

The Examiner notes that the disclosed invention is within the technological arts. The claimed invention is also noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. The claimed invention does not include a series of steps to be performed by a computer. The claimed invention also is not a product for performing a process, nor is it a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction. Claims 1-3, 6-11, 15, 17-31, 33-37, 39-49, 52-56, 59-68, 71-88 do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. Claims 1-3, 6-11, 15, 17-31, 33-37, 39-49, 52-56, 59-68, 71-88 do not appear to correspond to a specific machine or manufacture, and thus encompass any product of the class configured in any manner to

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perform the underlying process. The claimed invention of claims 1-3, 6-11, 15, 17-31, 33-37, 39-49, 52-56, 59-68, 71-88 also do not include a post-computer process activity or a pre-computer process activity. Thus, no physical transformation is performed, no practical application in the technological art is found. Consequently, claims 1-3, 6-11, 15, 17-31, 33-37, 39-49, 52-56, 59-68, 71-88 are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process.

See *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 47 USPQ2d 1597 (Fed. Cir. 1998) where the Federal Circuit held that: "[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it provides "a useful, concrete and tangible result".

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 & 66-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deming (US Patent 4,823,264) in view of Thomas et al (hereinafter Thomas, US 6173,272) and Kitchen et al (hereinafter Kitchen - US 6,289,322).

Re. Claims 1-3, Deming discloses an electronic fund transfer (EFT) system/method/computer from payer's account to Payee or to Payee's account using National Automated clearing House Association facility, and routing and transfer number (RTN) [see entire document particularly, Fig. 1; C1 L1 to C3 L6]. Deming, explicitly, does not disclose source account's RTN and receiving from the receiver the designation of the target account for receiving the funds from the sender. However, Thomas discloses receiving from the receiver the designation of the target account for receiving the funds from the sender [see entire document particularly, Abs; Figure 1, 2A, 3, 7; C3 L45 to C5 L34; C15 L1-L30]. Further, Kitchen discloses source account's RTN. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Deming, Thomas and Kitchen to enable the payer to initiate an electronic payment without knowledge of a special identifier corresponding to the biller's bank and account number from a particular source account.

Re. Claims 4-7, Deming disclose receiving the amount of the funds transfer (bill). Deming, explicitly, does not disclose receiving the amount of the funds transfer, the designation of the source account for the funds transfer, and the contact information of the receiver from the sender [C1 L5 to C3 L8]. Deming, explicitly, does not disclose the way the bill is received (i.e. by phone, email, web page, etc.). However, Thomas discloses these steps [C3 L14-L23]. Mail, Email, telephone, voice mail, voice over IP, on-line billing and pager are well known to one skill in the art as a common

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communication media used by the billers to communicate with customers, therefore one can combine the teaching of Doming and Thomas to present electronic bill information by electronic media, explained above, instead of regular mail to save time reduce cost.

Re. Claims 66-70, Deming discloses an electronic fund transfer (EFT) system/method/computer from payer's account to Payee or to Payee's account using National Automated clearing House Association facility, routing and transfer number (RTN) and substantially recites claims features [see entire document particularly, Fig. 1; C1 L1 to C3 L6]. Deming, explicitly, does not disclose receiving from the receiver the designation of the target account for receiving the funds from the sender. However, Thomas discloses this step [see entire document particularly, Abs; Figure 1, 2A, 3, 7; C3 L45 to C5 L34; C15 L1-L30]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Deming and Thomas to enable the payer to initiate an electronic payment without knowledge of a special identifier corresponding to the biller's bank and account number.

Claims 8-65, 71-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deming, Thomas and Kitchen and further in view of Schrader et al (hereinafter Schrader, US 5,903,881).

Re. Claims 8-65 Deming discloses an electronic fund transfer (EFT) system/method/computer from payer's account to Payee or to Payee's account using

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National Automated clearing House Association facility, routing and transfer number, transaction amount, payer starts initiating EFT using PC and entering payee information (target information), identification code, description of transaction (bill identification), crediting the debiting accounts, means for verifying payers account code [Fig. 1; C1 L1 to C4 L67]. Thomas discloses electronic funds transfer and bill presentment. Both Deming and Thomas substantially recite claims features. Neither Both Deming and Thomas nor Kitchen, explicitly, disclose registering and storing list of receiver, first account balance and second account balance, insufficient fund, and POS & ATM. However, Schrader discloses these steps [see entire document particularly, Abs; Fig. 9-12, 14-17; C1 L5-L34; C13 L65 to C14 L15; C15 L45 to C16 L39]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Deming, Thomas, Kitchen and Schrader to enable the payer (payers bank) make sure the payer's account has sufficient fund to be transferred and allow the payer to make payments by selecting a payee from a list of known payees using the dropdown button instead of re-entering the payee information.

Re. Claims 71-72, Deming and Thomas substantially disclose the claimed features. Neither Deming nor Thomas, explicitly, discloses sender's source account for funds transfer. However, Kitchen discloses this feature [see entire document particularly, Abs; fig. 6; C11 L14-L56]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Deming, Thomas

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and Kitchen to enable the authorized billers' to withdraw money from a particular account.

Re. Claims 73-83, Deming and Thomas substantially disclose the claimed features.

Neither Deming nor Thomas, explicitly, discloses receiving account activity information, querying a balance of source account and balance exceeding the amount (overdraft).

However, Schrader discloses these features [C1 L6 to C7 L15]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to combine disclosures of Deming, Thomas, Kitchen and Schrader to enable the sender to reconcile its account and avoid overdraft and excess withdrawal.

Re. Claim 85-101, contain features recited in above claims 1-65 and therefore claims 85-89 are rejected under a similar rationales.

Response to Arguments

3. Applicant's arguments with respect to claims 1-101 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US Pat. 6,032,133 to Hilt et al, Feb. 29, 2000 "Electronic bill pay system". Hilt et al discloses a method for electronically paying a bill is described in which a bill pay order is forwarded to a first processor. The bill pay order includes information identifying a biller, an amount owed, and a consumer-biller account number. The method determines whether the consumer has sufficient funds to cover the amount owed, and compares the information identifying the biller to a local biller file to determine a biller financial institution identification number for a financial institution designated to receive funds for the biller. A payment message is then generated which includes information identifying the biller, the amount owed, the consumer-biller account number, and the biller financial institution identification number. The payment message is then forwarded to a network if the consumer has sufficient funds. The payment message is routed to the appropriate biller financial institution over the network using the biller financial institution identification number.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

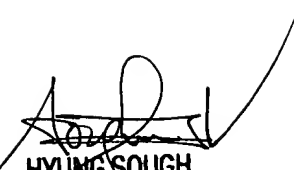
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Harish T Dass *HTD*
Examiner
Art Unit 3628

9/12/03



HYUNG SOUGH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600